REMARKS

Claims 23-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshida et al. in view of Madrange and Ikemoto et al. as evidenced by Pearson et al.

Yoshioka et al. discloses hair and skin cosmetic compositions comprising a silylated peptide which may also contain L-arginine, an anti-inflammatory (antiphlogistic) agent and a wetting agent such as 1,3-butyleneglycol. There is no mention in Yoshioka et al. of the presence of any free ethanolamine in the disclosed composition.

Madrange et al. teaches cosmetic compositions for dyeing or bleaching hair which may contain, in addition to many other components, an alkalizing agent such as ethanolamine.

Ikemoto et al. discloses an emulsion-type cosmetic composition containing a surfactant comprising a trehalose-6-fatty acid ester and which may also contain a polyvalent alcohol such as 1,3-butyleneglycol.

Pearson et al. teaches that L-arginine can be obtained from rice.

As stated in the Office Action, the rejection under 35 U.S.C. 103(a) is apparently based on the conclusion that since Yoshioka et al., Madrange et al. and Ikemoto et el., all disclose compositions that can be applied to the skin, they all are useful for the same purpose, and that it would therefore be obvious to add any of the components of the compositions of Madrange et al. or Ikemoto et al.,

particularly the ethanolamine disclosed by Madrange et al., to the composition of Yoshioka et al. In reply to this position in support of the rejection, the following points should be considered.

The compositions disclosed by Yoshioka et al. and Madrange et al. cannot be considered as useful for the same purpose merely because they both may be applied to the skin. Thus, Yoshioka et al. discloses cosmetic compositions broadly while the application of the compositions of Madrange et al. is limited to the dyeing or bleaching of hair. In view of this, a person having ordinary skill in the art would not be led to add the ethanolamine of Madrange et al. to the composition of Yoshioka et al.

The outstanding Office Action on page 3 beginning at line 10, quotes the Manual of Patent Examining Procedure (MPEP) Section 2144.06 (although the Office Action has "2114.06" written, Applicants assume that Section 2144.06 was intended) that "it is prima facie obvious to combine two or more compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the same purpose...". This statement is then interpreted for the purpose of the rejection to mean in effect that it is prima facie obvious to combine any components in cosmetic compositions disclosed in two or more references to form a third cosmetic composition. This interpretation of the MPEP statement is too broad since the fact that components are present in cosmetic compositions of any type is not sufficient to conclude that they have the

same purpose. Thus, the components of the compositions of Madrange, which are used for the dyeing or bleaching of hair would be expected to have purposes somewhat different than those of the compositions of Yoshioka, Ikemoto, or those covered in the present claims which are intended to treat only the surfaces of skin or hair. As an illustration of this point, it is noted that ethanolamine as employed in the present application serves as a direct skin conditioner (page 4, lines 1-3 of the specification) whereas in the compositions of Madrange, it acts only as an alkalizing agent; (see claim 1 at col. 23, line 50 and claim 15 at col. 31, line 62).

The cited portion of the MPEP states that "[i]t is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose." (emphasis added). The MPEP attributes this citation to *In re Kerkhoven*. The various components that the Office Action attempts to combine have not been shown to be useful for the same purpose nor are they being used to form a third compositon to be used for the very same purpose. In *In re Kerkhoven*, the claimed invention merely mixed together two conventional spray-dried detergents. There is no indication in *In re Kerkhoven* or any other case that would support the Examiner's position that components which are disclosed as included in a cosmetic would be automatically *prima facie* obvious to mix in any combination using any reference to arrive at a claimed invention. Moreover, the Federal Circuit has made it clear that reliance on *per se* rules of

obviousness is legally incorrect. *See In re Ochiai*, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995). Additionally, the Supreme Court has made clear that a claim composed of several elements "is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art" and stated the importance of identifying "a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." *See KSR International Co. v. Teleflex Inc. et al.* 82 USPQ2d 1385, 1396 (2007). The fact that a component may be used in a cosmetic does not provide the necessary reasoning for mixing this component with other components that may be used in cosmetics. A reason must be provided for such combination and the Office Action has not provided the necessary reasoning.

Additionally, as stated above, the purpose of using monoethanolamine in Madrange et al. is as an alkalizing agent. There is no indication that the use of the L-arginine in Yoshioka et al. is as an alkalizing agent. Accordingly, the uses of the components are different and it would not be obvious to combine them for the same purpose since they are not identified as having the same purpose.

Moreover, one of ordinary skill in the art would not assume that ethanolamine used as an alkalizing agent in the complex composition of Madrange et al. (col 12, line 48, claim 15) would be useful for the same purpose in the

substantially different composition of Yoshioka et al. This would further militate against the addition of ethanolamine to the composition of Yoshioka et al.

In addition to the foregoing factors working against the addition of the ethanolamine of Madrange et al. to the composition of Yoshioka et al., the elected composition of the presently claimed invention comprising L-arginine, ethanolamine, dipotassium glycyrrhetinate as an antiphlogistic agent, and 1,3-butyleneglycol has a significant improvement effect in the treatment of atopic dermatitis. This is shown in the chemical test results described in Test Example 13 on pages 46-49 and Test Example 14 on pages 49-51 of the specification, and is further discussed on pages 10 and 11 of the Amendment mailed to the USPTO September 3, 2006. It is submitted that this is an unobvious result which further supports the patentability of the elected composition over the relied on references.

The Office Action on page 4, second full paragraph takes the position that the argument that the improvement in the treatment of atopic dermatitis provided by the elected composition is an unobvious result supporting patentability, is not persuasive because "applicant has not claimed any specific effective amounts and/or ranges of active ingredients within its claimed composition to determine whether applicants' claimed composition invention demonstrates unexpected results and synergism". The combination itself in the present invention is critical and therefore that is sufficient to show the advantages of the present invention. Furthermore, the identification of the components together with the guidance

provided by the specific examples would enable a person having ordinary skill in the art to arrive at and utilize a composition which achieves the desired unobvious result of minimizing the symptoms of atopic dermatitis, without undue experimentation.

No fee is believed due. If there is any fee due the USPTO is hereby authorized to charge such fee to Deposit Account No. 10-1250.

In light of the foregoing, the application is now believed to be in proper form for allowance of all claims and notice to that effect is earnestly solicited.

Respectfully submitted,
JORDAN AND HAMBURG LLP

By C. Bruce Hamburg
C. Bruce Hamburg
Reg. No. 22,389
Attorney for Applicants

and,

By Ricardo Unikel
Ricardo Unikel
Reg. No. 52,309
Attorney for Applicants

Jordan and Hamburg LLP
122 East 42nd Street
New York, New York 10168
(212) 986-2340